



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/485,070 06/07/95 GETREUER

K 37436.D-1

022887  
DISCOVISION ASSOCIATES'  
PATENT PROSECUTION DEPARTMENT  
P O BOX 19616  
IRVINE CA 92623

WM02/0430

EXAMINER

DINH, T

ART UNIT	PAPER NUMBER
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2651

DATE MAILED:

04/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

See the letter attached herein.

Art Unit: 2651

1) The letter requests for withdrawal of the Terminal Disclaimer filed on 10/25/1999, filed 06/07/2000 is acknowledged. However, this requested is not found persuasive. Applicant needs to file a petition under 37 CFR 1.182 for withdrawing a terminal disclaimer ( see the paragraph below ).

### **WITHDRAWING A RECORDED TERMINAL DISCLAIMER**

If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent, or in a reexamination proceeding before the reexamination certificate issues. After a patent or reexamination certificate issues, it is unlikely that a recorded terminal disclaimer will be nullified.

#### **Before Issuance Of Patent.**

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "un-happy circumstance" In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by *filing* a petition under **37 CFR 1.182** requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application other than a CPA, while

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abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer.

Applicant is given **30 days** for this notice.

2) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN DINH whose telephone number is (703)308-4859. The Examiner can normally be reached on Monday - Friday from 8:00AM to 5:30PM.

The *fax phone number* for the organization where this application or proceeding is assigned is (703)308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



TAN DINH  
PRIMARY EXAMINER

April 25, 2001